



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,612	03/09/2001	Sami Uskela	617-010120-US	1625
2512	7590	01/20/2004	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			OMARY, NAWARA T	
			ART UNIT	PAPER NUMBER
			2683	

DATE MAILED: 01/20/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,612

Applicant(s)

USKELA, SAMI

Examiner

Nawara T. Omary

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/03/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4-8, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (Patent #4,737,978) in view of Schmidt (Patent #5,682,416).

In regard to Claim 1, Burke discloses a method for performing handover of a mobile station communicating in a first call via a first network to communication in a second call via a second network, comprising (Abstract)(Fig. 1): generating a request for handover (C10, L.24-26); establishing the second call between the first network and the mobile station via the second network (C1, L.64-66)(C11, L.41-64). However, Burke does not disclose transferring data communication between the mobile station and the first network from the first call to the second call. Schmidt explicitly teaches in his method and apparatus the data communication transfer step between two communication entities as a mobile station or terminal moves from one area to another (Abstract)(C2, L.50-60). Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to follow Schmidt on Burke in order to prevent communication disruption.

In regard to Claim 2, Burke discloses the step of releasing the first call after data communication between the mobile station and the first network has been transferred from the first call to the second call (Fig. 5b, Block 240)(C8, L.10-13).

In regard to Claim 4, Burke also discloses the method wherein the first network generates the request for handover (C12, L. 15-20).

In regard to Claim 5, Burke also discloses a method wherein the mobile station originates the second call (C8, L.48-53, L.60-67)(C9, L.1-16).

In regard to Claim 6, Burke discloses a method wherein: the first network transmits to the mobile station data indicating an identification for the handover operation; the mobile station transmits to the second network data indicating that identification; and when the second call has been established the second network transmits to the first network data indicating that identification (Abstract)(C10, L.33-67)

In regard to Claims 7 and 8 Schmidt discloses in his modified system a method wherein the first network originates the second call, and the mobile station transmits its identification in the second network to the first network and the first network uses that identification in originating the second call (C2, L.50-60)(Fig. 3C)(C4, L.19-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to follow Schmidt on Burke in order to provide a better handover method.

In regard to Claims 12 and 13, Burke discloses that the first and second networks are cellular telephone networks. Wherein, the mobile station is capable of communicating by radio with the first and second networks (Abstract)(C2, L.26-29).

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (Patent #4,737,978) in view of Schmidt (Patent #5,682,416) in further view of Kumaki (Patent #6,473,411).

In regard to Claim 3, the combined system of Burke and Schmidt does not explicitly disclose the method wherein the mobile station generates the request for handover. Kumaki teaches in his modified system the handover request to be initiated by the mobile terminal (C34, L.14-L.57). Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to further modify Burke's method so as to include Kumaki's in order to provide a better handover process.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (Patent #4,737,978) in view of Schmidt (Patent #5,682,416) in further view of Gillig (UK Patent #2,225,512).

In regard to Claim 9, Burke discloses a handover method between two cellular networks with overlapping regions of coverage as indicated in his Abstract. However, Burke does not disclose the size of coverage areas in which the second network is larger than the first network. Gillig teaches the amount of coverage provided by each network where the second network (cellular) has a greater region of coverage than the first network (Fig.1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to assign the second network to be larger in size than the first network in order to provide a better handover process.

5. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (Patent #4,737,978) in view of Schmidt (Patent #5,682,416) in further view of Korpela (Patent #6,510,146).

In regard to Claims 10 and 11, Burke discloses two adjacent cellular networks as indicated in his Abstract. However, Burke does not disclose the type of such cellular networks. Korpela teaches the adjacency of second-generation digital cellular networks, such as GSM, PDC, etc to new third generation networks such as IMT-2000 and FPLMTS etc. (C1, L. 38-55). Such adjacency of networks is important in order to provide mobile users with the most possible uninterrupted service. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to specify the second network to be an IMT-2000 and the first network to be a PDC in order to provide subscribers with a better quality of service.

Response to Arguments

6. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejection explicitly show (Burke in view of Schmidt) the communication transfer between two communication entities as a mobile station travels. Also, the method wherein the first network originates the second call and the transfer of identification in the second network to the first network for the first network to use this identification in originating the second call. Furthermore, Kumaki's reference teaches the method of a mobile terminal originating a handover request. All other dependent claims comply to references accordingly.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nawara T. Omary whose telephone number is 703.305.6311. The examiner can normally be reached on 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703.308.5318. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.0377.

Nawara T. Omary



January 10, 2004



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600